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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/826,612
Filing Date: April 05, 2001
Appellant(s): FORSYTH, GORDON A.

Gregory A. Welte
(Reg. No. 30,434)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/22/2009 appealing from the Office action mailed 11/14/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,945,457	BARCELOU	9-2005
6,282,618	FLENLEY	8-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over BARCELOU in view of FLENLEY.

BARCELOU discloses a self-service terminal for connection to a network (40), the terminal comprising:

--means for receiving payment from a user (52--cash acceptor) (see fig. 4, col. 4, lines 50-65), **as in claims 1,**

--an electronic payment mechanism for creating an electronic financial instrument for paying for an item purchased via the network, wherein the electronic financial instrument is independent of the payment from the user (see fig. 5, col. 4, lines 66 to col. 5, line 12), **as in claims 1**

--comprising means for recording each electronic financial instrument created and transmitting a copy to a database for

Art Unit: 3693

reconciling with transactions processed at that terminal, (see col. 4, 11.31-33), **as in claim 6, 16 and 17**

--comprising a printer for printing out a receipt to confirm that the electronic financial instrument has been created and sent, (see "printer" (57), col. 5, 11.8-9), **as in claims 7 and 18,**

--receiving from a user an indication of an item for purchase using the terminal see fig. 5, col. 4, lines 66 to col. 5, line 12);

--receiving from the user a first form of payment for purchasing the item (see fig. 4, col. 4, lines 50-65); and

BARCELOU discloses the use of the Internet and a touch screen which provides for a wide variety of goods and services to be viewed (see col. 4, lines 50+), but fails to disclose a browser for enabling a user to browse sites on the network to select an item for purchasing from a merchant, **As in claims 2, 8, 13 and 19.**

Art Unit: 3693

FLENLEY discloses an ATM (fig. 2) that uses a browser (80) (see col. 5, lines 23-28). It would have been obvious for one of ordinary skill in the art artisan at the time of the invention modify Barcelou with the Internet browser of Flenley because an artisan at the time of the invention would have sought to use the notoriously old and well known Internet browser as an alternative to Barcelou's touch-screen to provide viewing and selection of various goods and services.

BARCELOU further discloses a method of purchasing items using an Automated Teller Machine, ATM comprising:

- Providing a web browser to a user of the ATM for browsing web pages of merchants;

- receiving payment via a first credit card from the user for a purchase from a selected merchant; and

- using credit card account assigned to the ATM, transmitting payment to the selected merchant.

- using the account to make payment to the selected merchant without identifying the user to the merchant, and

Art Unit: 3693

without disclosing an account number of the user to the merchant
(see fig. 5, col. 4, lines 66 to col. 5, line 12)

(10) Response to Argument

Response to points 1-5: In summary the appellant asserts that the Barcelou in view of Flenley does not show 1 b

"...b) means for delivering a third part payment to a third party or merchant, who is different from the user and different from the operating party, which the third party payment i) is made using a credit card assigned to the terminal, ii) does not allow the third party to learn the identity of the user, and iii) does not allow the third part to learn an account number of the user."

The appellant asserts that BARCELOU shows only a single payment, namely that by a customer and that two payments have not been shown by the references. In particular, the appellant asserts that *the ATM uses its own credit card to pay the seller* (point 4). The Examiner respectfully points out that the features upon which applicant relies (i.e., namely, that the ATM uses its own credit card to pay the seller) is/are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, it is respectfully submitted that limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover Examiner disagrees with the appellants assessment of the cited prior art. Barcelou provides a means to identify oneself to BARCELOU's ATM or system and not necessarily to the merchants themselves (see Barcelou column 4, lines 31-33) where it reads,

Art Unit: 3693

"...User access to systems provided according to the invention will normally be accomplished **by credit card**, smart card or other identification card, but other means are contemplated within the scope of the invention. Literally any means of positive identification of any given individual user **to the system** (emphasis added) can be implemented, such as iris or finger print scans matching to user databases."

It is being maintained that BARCELOU is disclosing identification of an individual to one system (or 'the' system) which is Barcelou's kiosk (40) through which the user can have access to other goods and services via the kiosk (or third party vendors).

Response to points 6 and 7; In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this regard Flenley was used in combination with Barcelou to disclose an ATM (fig. 2) that uses a browser (80) (see col. 5, lines 23-28). It was found by the combination of references that it would have been obvious for one of ordinary skill in the art artisan at the time of the invention modify Barcelou with the Internet browser of Flenley because an artisan at the time of the invention would have sought to use the notoriously old and well known Internet browser as an alternative to Barcelou's touch-screen to provide viewing and selection of various goods and services over an interactive interface.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3693

Respectfully submitted,

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